## REMARKS

Reconsideration of the present application as amended is requested. A request for a one month extension of time is transmitted herewith.

In the second Office Action mailed February 12, 2004, the examiner withdrew the indication of allowability of claims 6-10 set forth in the first Office Action. The examiner then proceeded to object to claims 6-7 for indefiniteness, reject claims 6-7 for alleged obviousness, and reject claims 8-10 for lack of novelty.

Claims 6 and 7 have been amended as suggested by the examiner to remove the references to ~~like~~ and to insert closest possible for clarity and in order to be consistent with the specification. Accordingly, withdrawal of the objection to claims 6-7 under 37 CFR §1.75(a) is requested.

Claim 6, an apparatus claim, has been rejected for alleged obviousness over "admitted prior art" in view of U.S. Patent No. 5,243,443 of Eschbach. Claim 7, a method claim, has been rejected for alleged obviousness on the same basis as claim 6, with the examiner noting that steps set forth in claim 7 allegedly correspond directly to the function of the means set forth in apparatus claim 6. The obviousness rejection of claims 6 and 7 is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expection of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991).

The admitted prior art relied upon by the examiner consists of two sentences in the specification (page 7, line 27 through page 8, line 2). These sentences merely indicate that

it is known to perform resolution conversion and color correction to best match RGB monitor color to the closest color that can be printed. The examiner correctly notes that these sentences do not disclose means for transforming the closest possible fixed bit color space value of another given resolution into a super pixel cell, wherein individual ones of the cells are assigned available output values and where the average of the values in said cells is selected to be as close as possible to said fixed bit color space value of another given resolution, as required by amended claim 6. However, the examiner contends that it would have been obvious to modify the admitted prior art in view of Eschbach to provide the aforementioned transforming means because "[s]uch a modification would provide an error diffusion technique [that] initially determines the best fit halftone cell (super pixel cell), and propagates a minimized halftone error in order to maintain gray density as suggested by Eschbach [citation omitted]." See second Office Action, page 5.

In rejecting claim 6 for alleged obviousness over the admitted prior art and Eschbach, the examiner has not met the legal requirements cited in *In re Vaeck, supra.* More specifically, the examiner has not cited any motivation set forth in Eschbach or in knowledge generally available to one of ordinary skill in the art, to modify the admitted prior art as proposed. The examiner has simply made the conclusary statement that the error diffusion technique of Eschbach initially determines the best fit super pixel cell and propagates a minimized halftone error in order to maintain gray density. Moreover, as set forth in Applicant's specification, page 3, lines 25-28, the object of Applicant's apparatus is to reduce the average error value in an error diffusion scheme, not to "maintain gray density" as sought by Eschbach. In addition, one of ordinary skill in the art would not have had a reasonable expectation of success in seeking to modify the admitted prior art in view of Eschbach given the extreme complexity of adapting the halftoning with error feedback approach of Eschbach to accommodate *color* space conversion. Finally, even assuming that the admitted prior art were modified in light of Eschbach as proposed by the examiner, the result would still not be the invention of claim 6. This is because Eschbach contemplates calculation of an error between the average gray value of the original image and the average gray value of the output image, and forwarding preselected fractions of the error to unprocessed pixels belonging to a preselected set of unprocessed halftone cells. See column 4, lines 3-8 of Eschbach. This radically different error feedback approach does not result in the final limitation of amended claim 6, namely, "wherein individual ones of the cells are assigned available output values

where the average of the values in said cells is selected to be as close as possible to said fixed bit color space value of another given resolution."

For the foregoing reasons, withdrawal of the obviousness rejection of claim 6 over the combination of the admitted prior art and Eschbach is requested. Withdrawal of the obviousness rejection of claim 7 over the admitted prior art and Eschbach is requested for the same reasons.

In order to expedite prosecution, claims 8-10 have been canceled, but Applicant does not by reason of said cancellation acquiesce to the correctness of the examiner's anticipation rejection. Applicant reserves the right to pursue claims 8-10 in a later filed continuation application.

The present application is in condition for allowance and notification to this effect is solicited. No additional fee is due at this time.

Respectfully submitted,

6-7-04

By: Michael H. Jester
Attorney for Applicant
Registration No. 28,022